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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,639	03/20/2001	Michael R. Levine	LVN-08602/03	1113

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,639

Applicant(s)

LEVINE, MICHAEL R.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-11 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of paying for medical costs. The recited steps constitute an idea on how to pay for medical costs.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for contracting between parties to pay for medical costs incurred by users. Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-11 are deemed to be directed to non statutory subject matter. The Examiner suggests amending the independent claims by adding language to the body of the claims (i.e. limitations) that indicates that at least some of the steps of the claimed invention are carried out using technology.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Volz, David, "Alternative care" (hereinafter Volz).

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As to claim 1, Volz discloses A method of payment for a healthcare service (see abstract), said method comprising the steps of:

issuing, by an intermediary, a healthcare credit card, debit card or other account mechanism to a healthcare user, wherein the healthcare user agrees to repay the intermediary for charges incurred by the healthcare user (page 1);

contracting by an intermediary with a healthcare provider, wherein the healthcare provider agrees to perform a predetermined healthcare service and charge the healthcare user a predetermined fee and the intermediary agrees to pay the healthcare provider the predetermined fee charged the healthcare user (page 2); and

using the card or other mechanism by the healthcare user to tender the predetermined fee for receiving the predetermined healthcare service, wherein the intermediary pays the healthcare provider the predetermined fee and the healthcare user reimburses the intermediary (page 2).

As to claim 4, Volz discloses A method as set forth in claim 1 including the step of billing the healthcare user by the intermediary for the healthcare service performed by the healthcare service provider (page 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volz in view of Sanders, Edmund, "Medical credit cards are an expensive Rx"(hereinafter Sanders).

As to claim 5, Volz discloses A method of payment for a healthcare service, said method comprising the steps of:

contracting between a healthcare provider and an intermediary for the healthcare provider to perform a predetermined healthcare service for a healthcare user and receive a predetermined fee (page 2);

contracting between a healthcare user and the intermediary for the healthcare user to pay the healthcare provider when the healthcare service is performed with a healthcare credit card issued by the intermediary (page 2);

receiving by the healthcare user the predetermined healthcare service from the healthcare provider (page 2);

charging the fee for the healthcare service using the healthcare credit card;

paying the healthcare provider by the intermediary according to the contract between the healthcare provider and the intermediary for the healthcare service charged to the healthcare credit card (page 2); and

paying the intermediary by the healthcare user according to the contract between the healthcare user (page 2).

Volz does not explicitly disclose

charging the fee for the healthcare service using the healthcare credit card;

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However, Sanders discloses charging the fee for the healthcare service using the healthcare credit card (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include charging the fee for the healthcare service using the healthcare credit card as disclosed by Sanders within Volz for the motivation of making loans to help people pay medical bills (see abstract).

As to claim 8, Volz discloses A method as set forth in claim 5 including the step of billing the healthcare user by the intermediary for the healthcare service performed by the healthcare service provider, after said step of paying the healthcare provider (page 2).

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volz as applied to claim 1 above, and further in view of information available at the web site of SimpleCare (hereinafter Simplecare).

As to claims 2 and 3, Volz does not explicitly disclose A method as set forth in claim 1 including the steps of:

providing the healthcare user access to a website hosted by the intermediary on a computer network;

identifying the healthcare user accessing the healthcare website;

providing the identified healthcare user access to a web page containing healthcare providers contracting with the intermediary; and

selecting by the healthcare user a healthcare provider from the contracting healthcare providers.

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However, Simplecare discloses providing the healthcare user access to a website hosted by the intermediary on a computer network (page 1); identifying the healthcare user accessing the healthcare website (pages 1-9); providing the identified healthcare user access to a web page containing healthcare providers contracting with the intermediary (pages 6-9); and selecting by the healthcare user a healthcare provider from the contracting healthcare providers (pages 6-9). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Simplecare within Volz for the motivation of accessing a network of healthcare providers for fees where the system reduces administrative costs associated with medical care and passes the savings to consumers in the form of reduced fees (pages 1-2).

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volz and Sanders as applied to claim 5 above, and further in view of Simplecare.

As to claims 6 and 7, Volz and Sanders do not explicitly disclose A method as set forth in claim 5 including the steps of:

providing the healthcare user access to a website hosted by the intermediary on a computer network;

providing the healthcare user access to a website hosted by the intermediary on a computer network;

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identifying the healthcare user accessing the healthcare website;
providing the identified healthcare user access to a web page containing healthcare providers contracting with the intermediary; and
selecting by the healthcare user a healthcare provider from the contracting healthcare providers.

However, Simplecare discloses
providing the healthcare user access to a website hosted by the intermediary on a computer network (page 1);
identifying the healthcare user accessing the healthcare website (pages 1-9);
providing the identified healthcare user access to a web page containing healthcare providers contracting with the intermediary (pages 6-9); and
selecting by the healthcare user a healthcare provider from the contracting healthcare providers (pages 6-9). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Simplecare within Volz and Sanders for the motivation of accessing a network of healthcare providers for fees where the system reduces administrative costs associated with medical care and passes the savings to consumers in the form of reduced fees (pages 1-2).

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volz, Sanders and Simplecare.

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As to claim 9, the claim is similar in scope to claim 6 and is rejected on the same basis.

As to claim 10, the claim is similar in scope to claim 7 and is rejected on the same basis.

As to claim 11, the claim is similar in scope to claim 8 and is rejected on the same basis.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Taking charge of Health" discloses using credit cards for medical costs
- b. "Medicaid moves to high tech" discloses using cards to identify recipients as eligible for health care benefits.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, sweeping initial "A".

Alexander Kalinowski

Primary Examiner

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9/25/2004